

Remarks

The applicant has carefully considered the Office action dated October 13, 2005, and the references it cites. By way of this response, claims 1, 23, 24, 26, 36, and 37 have been amended and claim 25 has been cancelled. In view of the following, it is respectfully submitted that all pending claims are in condition for allowance and favorable reconsideration is respectfully requested.

As a preliminary matter, the undersigned respectfully requests, the Office to acknowledge the priority claim of this application to German application 101 36 287.0 via the parent PCT application.

Election/Restriction

Regarding the restriction/election issue, the Office action dated October 13, 2005, contends that the applicant has incorrectly argued the requirements for restriction because the Office action of May 18, 2005, required an election of species and not a restriction. A few remarks are in order.

As an initial matter, MPEP 802.02 clearly defines a restriction as “requiring an applicant to elect a single claimed invention (e.g., a combination or subcombination invention, a product or process invention, a species within a genus) for examination...” (MPEP 802.02, emphasis added). Thus, a requirement to elect a species is a restriction and, therefore, the criteria for making a restriction apply to an election of species. Per MPEP 803 the criteria for making a restriction are: (1) the inventions must be independent or distinct and (2) there must be a serious burden on the examiner if a restriction is not required. To that end “[e]xaminers must provide reasons and/or examples to support conclusions...” (MPEP 803).

The response filed on June 30, 2005, pointed out the fact that the Office action dated May 18, 2005, did not make any showing as to the required rationales of independence, distinctiveness, or examiner’s burden. As such, the May 18, 2005, Office action, did not put the applicant in a position to meaningfully address the election requirement because the action was devoid of rationale regarding the required criteria for restriction. Therefore, the Office action did not help to advance the prosecution of the case by clarifying the issues.

In response to the applicant’s remarks on the subject, the Office action dated October 13, 2005, contends that MPEP 808.02 pertains only to restrictions, thereby implying that the

applicant has applied the incorrect standard to the election of species requirement. As noted above an election is a form of restriction and, thus, MPEP 808.02 pertains to elections. Section 808.01, it is contended in the October 13, 2005, Office action, is applicable to election of species requirement. This is true and, in fact, section 808.01(a), which is entitled "Species," states that "A requirement for restriction is permissible if there is a patentable difference between the species as claimed and there would be a serious burden on the examiner if restriction is not required." (MPEP 808.01(a)). Thus, the section cited by the Office action proves the applicant's point that a species election is a restriction that must be made according to the criteria specified in MPEP 803.

Interestingly, immediately following the above-quoted MPEP language are references to MPEP 803 and MPEP 808.02. As noted above, MPEP 803 requires that the Office provide rationales regarding independence, distinctiveness, and examiner's burden. Further, section 808.02, which was previously referred to by the applicant in the response dated June 30, 2005, and dismissed as impertinent to restrictions by the Office action of October 13, 2005, is referenced by the exact section that the Office action of October 13, 2005, contends sets forth the criteria for election of species.

The foregoing MPEP sections, and even section 808.01 referred to in the Office action of October 13, 2005, require reasoning regarding independence and distinctiveness, as well as a demonstration of examiner burden. Because the Office action of May 18, 2005, did not include the required reasoning regarding independence, distinction, and examiner burden, it was, and still is, respectfully submitted that the election required by the Office action did not comply with the standards set forth in the MPEP and, thus, did not serve to advance the case efficiently.

Nevertheless, as explained below, it is respectfully submitted that the independent claims read on the elected species A, 1, f. It is also respectfully submitted that the independent claims are in condition for allowance over the cited art. Because the independent claims are in condition for allowance, a reasonable number of species claims dependent therefrom are also in condition for allowance. Thus, it is respectfully requested that the withdrawn claims, which are dependent on the allowable independent claims, be examined and indicated to be allowable.

Preliminary Remarks Regarding First and Second Modules

Page 3 of the Office action dated October 13, 2005, contends that there is a similarity between a first module and a second module, whereas a blank module implies no such similarity. A review of claims indicates that this is not necessarily the case. While the second module may be similar to the first module, it may also be dissimilar. The only indication given by the claims regarding the natures of the first and second modules is that they are separate modules and they have the structures recited in the claims. Whether they are generally similar or dissimilar is not indicated, nor is any other relationship or design of operation or effect implied.

The Rejections Under 35 U.S.C. § 112

Claims 1, 22, 26, 35, and 37 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

The language “rear grip element” has been removed from claim 1 and, therefore, the rejection of claim 1 is moot and the merits of the rejection will not be addressed.

The terms “if” and “dropped” have been removed from claim 26 and, therefore, the rejections based on these terms are moot and the merits of the same will not be addressed.

It is respectfully submitted that the elimination of the issues with regard to claim 1, above, eliminate the rejections to claims 22, 35, and 37.

Functional Language Must Be Considered

The Office action dated October 13, 2005, includes a section between paragraphs 10 and 11 that allegedly explains the difference between an apparatus claim and a method of operation claim. In this section, the Office action contends that identifying a first authorized user, controlling the safety, preventing and permitting firing, and attaching the first module to the handle (collectively, the “subject phrases”) are “essentially method limitations or statements of intended or desired use, [which] do not serve to patentably distinguish the claimed structure over that of the reference.”

The Office action has concluded that the subject phrases are method limitations and/or statements of use, but has not explained how such a conclusion was reached. It is illustrative

to look deeper into the case law cited in the Office action for guidance as to exactly what constitutes a statement of use.

In *Ex parte Marsham* an apparatus claim recited a means for mixing that was completely submerged in developer material. The rejection of the subject claim was based on a reference that taught all of the structural limitations recited in the subject claim, but the mixer of the prior art was only partially submerged in developer material. The Board reasoned that the amount of submersion was immaterial to the structure of the mixer and, therefore, the rejection of the subject claim was proper. That is, when the structure of a claim is shown in the prior art, the use of the structure (i.e., submersion of the mixer) is not sufficient to distinguish the prior art. Importantly, the submersion of the mixer is not a limitation on the structure of the mixer itself.

In re Danly is a case in which identical structures were found in the claim and the prior art, but the claim recited that alternating current may be passed through part of the claimed structure. The CCPA held that the claim was not limited to actually using alternating current due to the “may” language in the claims. That is, the novelty of the invention was not in the structure, but what can be done with the structure. The language pertaining to passing alternating current through the structure did not further define what the structure does, but what may be done to the structure. Again, like *Ex parte Marsham*, the alternating current recitation was not a limitation on the structure of the claim; it did not further refine what structural elements of the claim do or how they are constructed.

The *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, case stands for the proposition that as long as the structure recited in a claim is different than the structure in the prior art, it need not operate differently to be patentable. This is a case in which the defendant contended that the plaintiff needed to show operational differences to avoid the prior art.

The Office action apparently cites these cases for the proposition of an all out bar on the use of functional language that defines how a structure operates. These cases simply do not support such a proposition. The common thread in the first two cases is that the language recited therein is truly field or context of use language. That is, the language at issue in these cases did not refine the structure of the claim or define the interaction between parts of the recited structure. The parts of the claims that are “ignored” in these cases are either optional (e.g., the use of the term “may” in the language of the claims of *In re Danly*) or state the

positional relationship of claimed structure to unclaimed material (e.g., the depth of the mixer in *Ex parte Marsham*). The third case, merely states that it is not possible to avoid the prior art by stating that an identical apparatus in the prior art, as a whole, operates differently than the claimed apparatus.

The cases cited in the Office action of October 13, 2005, do not bar or render ignorable any form of functional language. In fact, contrary to the contention of the Office action, MPEP 2173.05(g) states that:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients. There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper.

(emphasis added). Further, this section of the MPEP states that:

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.

(MPEP 2173.05(g) (emphasis added)).

These sections clearly indicate that functional language may be used to define further a recited element and that the recited purpose must be considered, just like any other limitation of the claim.

Turning now to the subject phrases, each of the phrases refines an element. For example, the phrase “identifying a first authorized user,” “controlling the safety,” and “preventing and permitting firing” refine the structure of the electronic identification device, “attaching the first module to the handle” refines the structure of the first module and the handle. It is respectfully submitted that, in direct contrast to statements of field of use, the subject phrases are required to be given patentable weight.

The Rejections Under 35 U.S.C. §§ 102 & 103

Claims 1-22, 26, 27, and 37

Claim 1 reads on the elected species A, 1, f.

Claim 1 recites, *inter alia*, a first module removably attachable to a handle, the first module containing an electronic identification device identifying a first authorized user, the electronic identification device controlling the safety to prevent firing by unauthorized persons and to permit firing by the first authorized user when the first module is attached to the handle. Claim 1 further recites a second module removably attachable to the handle in place of the first module such that the first and second modules are interchangeable, the second module interacting with the safety when the second module is attached to the handle to affect the ability to fire the firearm.

The Office action dated October 13, 2005, rejected claim 1 as anticipated by Teetzel. Teetzel is a voice activated weapon lock apparatus that is designed to fit into handgrips that replace factory provided handgrips. Teetzel does not, however, describe an apparatus having a second removable module attachable to a handle in place of a first module, wherein the second module interacts with a safety to affect the ability to fire the firearm.

While the Office action makes a general suggestion that interchangeable parts are well known, it is respectfully submitted that Teetzel, nor any other art applied by the examiner, describes a system in which a first module containing an electronic identification device could be interchanged for a second module that affects the ability to first the firearm.

Because none of the applied art discloses or suggests the recited combination, it follows that none of the cited art anticipates or renders obvious claim 1. Thus, it is respectfully submitted that claim 1 is allowable. Claim 1 is generic to all the claims that depend therefrom. Therefore, examination and allowance of claim 1 and the claims dependent on claim 1 are respectfully requested.

Claims 23 and 24

Independent claim 23 has been amended to recite, *inter alia*, a first module and a second module. The language pertaining to a "blank module" has been removed from the claim, thereby broadening claim 23 because the second module need not be a "blank"

module. Claim 23 reads on the elected species A, 1, f, and, therefore, should be considered for purposes of patentability.

The first module is removably attachable to the handle and contains an electronic identification device to identify an authorized user, the electronic identification device controls the safety to prevent firing by unauthorized persons and to permit firing by the authorized user. The second module is for installation in place of the first module, wherein the second module prevents firing by all persons.

It is respectfully submitted that none of the applied art describes or suggests the recited combination. For example, Teetzel does not describe or suggest the combination of the first module with a second module, wherein the second module prevents firing by all persons. Accordingly, Teetzel cannot anticipate claim 23.

Claim 23 is generic to claim 24 and, as noted above, reads on the elected species. Thus, consideration and allowance of claims 23 and 24 are respectfully requested.

Respectfully submitted,

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